Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
03-1840

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number	Filed
	10/735,160	12/12/2003
on ___August 23, 2006___ Signature	First Named Inventor **Balasubramanian**	
Typed or printed name ___Louise Fay___	Art Unit **2189**	Examiner **Gu, Shawn X.**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
　　　　Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
　See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
　(Form PTO/SB/96)

☒ attorney or agent of record. Registration number ___36,975___

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____ Signature

Lisa L.B. Yociss
Typed or printed name

972-385-8777
Telephone number

Aug. 23, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of ___1___ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: **Balasubramanian**	§	
	§	
Serial No.: **10/735,160**	§	Group Art Unit: **2189**
	§	
Filed: **December 12, 2003**	§	Examiner: **Gu, Shawn X.**
	§	
For: **Removable Flash Backup for**	§	Attorney Docket No.: **03-1840**
Storage Controllers	§	
	§	

24319

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF APPLICANT'S PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicant requests that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to Deposit Account No. 12-2252.

REMARKS

Applicant hereby requests a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed June 23, 2006. The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Claims 1-20 are pending in the present application.

The Examiner has rejected claims 1-12, 14, 15, and 18-20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2003/0177149, published by *Coombs*. This rejection is clearly in error, thereby necessitating this pre-appeal brief review.

Applicant claims backup parameters, which are set by an operator, that define how a backup operation will be executed. A backup operation is invoked using the backup parameters.

Responsive to a given event, two steps occur. The first step is: determining if a removable non-volatile memory module is connected to a first storage controller. The second step is: responsive to the removable non-volatile memory module being connected to the first storage controller, executing the backup operation to store configuration information from the first storage controller to the removable non-volatile memory module.

Coombs teaches a system and method for data backup. A computer system 10 includes a primary storage device 22 and a backup storage device 24 that are connected to a device controller 20. *Coombs* describes backing up data that is stored on primary storage device 22 to backup storage device 24. Full and incremental backups are stored to the backup device.

Coombs is concerned, primarily, with creating and managing many different incremental backups. For example, a tree 40, see Figure 2, includes a root node 42 which represents a full backup. Many incremental backups are also depicted that are weekly, daily, or micro backups. *Coombs* describes restoring any one of these incremental backups. *Coombs* also describes managing the backups by balancing the desire for granularity with the available storage space. See *Coombs*, paragraph 0041.

As discussed above, *Coombs* teaches a primary storage device 22 and a backup storage device 24 that are connected to a storage controller. When a backup is to be performed, *Coombs* teaches performing the backup. *Coombs* does not go through a process of first determining if the backup storage device 24 is connected to a controller before performing the backup. *Coombs* just assumes that a backup storage device is connected because it simply performs the backup without first checking to see if a storage device is present.

Coombs also teaches the primary and backup storage devices including a mountable (selectively removable) disk drive. See *Coombs*, paragraph 0022. Again, *Coombs* does not

determine if the mountable disk drive is present before backing up data. *Coombs* assumes one is present because it performs the backup without checking for the presence of a mountable drive.

Regarding the feature of determining if a removable non-volatile memory module is connected to a first storage controller, the Examiner refers to paragraphs 0022, 0027, and 0028, which are reproduced below.

> [0022] Computer system 10 may be a multi-user or single-user system, including a server, mainframe, personal computer (PC), workstation, laptop, or the like. Each of primary storage device 22 and backup storage device 24 includes rewriteable media such as a fixed disk drive, mountable (i.e. selectively removable) disk drive, disk drive array or other rewriteable media, though magnetic tape or other sequential media are not preferred.

> [0027] A primary storage device such as device 22 typically contains two general data types, namely system files and user files. Once loaded and configured via one or more system configuration files, most system files rarely change over time. Preferably, the system files may be coupled to computer system 10 via a separate storage device such as a 32 Mb flash disk available from SimpleTech, Incorporated of Santa Ana, Calif. Conveniently, such storage devices provide quick access times for transferring data to CPU 12 and are primarily read-only in nature thus reducing the need for backup. Any system configuration files may be stored on primary storage device 22 to permit changes to the configuration and to facilitate convenient backup with other user files.

> [0028] In accordance with a preferred practice of the invention, the backup process coordinates periodic "full" (i.e. non-incremental) and "incremental" backups of the one or more system configuration files and the user files from primary storage device 22 to backup storage device 24. A full backup is a copy at a particular point in time of all the files to be backed up from primary storage device 22. An incremental backup is a copy at a particular point in time of data files to be backed up from primary storage device 22 and that were changed or added to primary storage device 22 subsequent to a previous backup. The incremental backup may be performed relative to a full backup or another incremental backup as is well understood by persons skilled in the art. Moreover, the previous backup from which an incremental backup is based need not be the most recent backup as will be explained further below.

The Examiner asserts that Applicant's claimed feature "determining if a removable non-volatile memory module is connected to a first storage controller" is taught by *Coombs* in these paragraphs. Applicant disagrees.

Nothing in these paragraphs, or anywhere else in *Coombs*, teaches a determining step. *Coombs* teaches simply that a backup is performed. *Coombs* does not teach first determining whether a memory module is connected before performing the backup.

The Examiner asserts, in paragraph 6 on page 3 in the Final Office Action, that backing up data to the removable device requires determining whether the device is connected to the

processor or not. In this assertion, it appears that the Examiner agrees that *Coombs* does not actually teach a determining step. The Examiner appears to believe that because data is backed up, there must necessarily be a "determining" step; however, such a step is not taught by *Coombs*. Therefore, *Coombs* does not anticipate Applicant's claims because *Coombs* does not teach all of the features of Applicant's claims.

Applicant also claims the combination of determining if a removable non-volatile memory module is connected to a first storage controller; and responsive to the removable non-volatile memory module being connected to the first storage controller, executing the backup operation to store configuration information from the first storage controller to the removable non-volatile memory module. These two steps are performed responsive to a given event.

Assuming, for the sake of argument, that *Coombs* is found to teach the step of "determining", nothing in *Coombs* teaches when such a determination is made. To anticipate Applicant's claims, *Coombs* must teach both a determination step and the step of executing the backup operation in response to the same given event. *Coombs* does not teach both determining if a module is connected and then executing the backup if such a module is found to be connected in response to the same event.

Coombs does not teach all of the features of Applicant's claims. Therefore, this rejection should be reversed.

The Examiner has rejected claims 13 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Coombs* in view of U.S. Patent 5,410,707, issued to *Bell*. This rejection is clearly in error, thereby necessitating this pre-appeal brief review.

The Examiner relies on *Bell* to cure the deficiencies of *Coombs*. *Bell* does not cure the deficiencies of *Coombs*; therefore, these claims are not rendered obvious by the combination of *Coombs* and *Bell*.
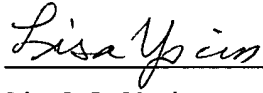
The Examiner has rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Coombs* and *Bell* and further in view of U.S. Patent 5,404,485, issued to *Ban*. This rejection is clearly in error, thereby necessitating this pre-appeal brief review.

The Examiner relies on *Ban* to cure the deficiencies of the combination of *Coombs* and *Bell*. *Ban* does not cure the deficiencies of the combination of *Coombs* and *Bell*, therefore, these claims are not rendered obvious by the combination of *Coombs*, *Bell*, and *Ban*.

The Pre-Appeal Brief Conference Panel is invited to call the undersigned at the below-listed telephone number if in the opinion of the Panel such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: <u>August 23, 2006</u>

Respectfully submitted,

Lisa L.B. Yociss
Reg. No. 36,975
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicant